No. 03-563

IN THE

Supreme Court of the United States

ALAN WANER,

Petitioner,

v.

FORD MOTOR COMPANY,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION

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RESPONDENT'S STATEMENT OF THE QUESTIONS PRESENTED

1. Whether Petitioner's request that this Court review the Federal Circuit's *de novo* review of claim construction seeks an advisory opinion, because the Federal Circuit did not resolve any conflicting factual evidence in reaching its construction.

2. Whether Petitioner's request that this Court review the Federal Circuit's JMOL of non-infringement seeks an advisory opinion, because there were no factual disputes concerning the nature of the accused product, and the accused product does not meet the claims as construed by the Federal Circuit.

3. Whether the Federal Circuit properly held that federal patent policy preempts and bars a state law unjust enrichment claim that is based on unpatented subject matter that Petitioner freely disclosed to the public.

STATEMENT PURSUANT TO RULE 29.6

Respondent, Ford Motor Company, has no parent corporation and no publicly held company owns 10% or more of its stock.

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517 U.S. 370 (1996) 4, 5

SUMMARY OF OPPOSITION

The Petitioner raises three issues. For the first two issues, Petitioner seeks an advisory opinion — the issues have nothing to do with the facts of this case. The third issue was resolved against Petitioner in *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989).

Petitioner's first issue — that the Federal Circuit is improperly "reviewing claim construction *de novo*, even on matters that involve questions of fact" — has nothing to do with this case because the Federal Circuit's claim construction in this case did not resolve any question of fact. The Federal Circuit did not even consider expert testimony, let alone resolve competing expert testimony or address credibility issues.

Petitioner's second issue — that the Federal Circuit "depriv[ed] Waner of the opportunity to present evidence of infringement based on the Federal Circuit's claim construction" — also has nothing to do with this case because Petitioner has not identified and cannot identify any evidence of infringement that it would present on remand. The nature of the accused device is simple and undisputed — a flat piece of plastic used as a fender liner for pickup trucks. Based on the undisputed nature of the accused device, it does not meet the claims as construed by the Federal Circuit. To the extent remand might be useful in some other cases, it would be a waste of time here.

Petitioner's third issue — whether the Federal Circuit correctly "refused to allow [Petitioner's] state law claim of unjust enrichment to proceed" — was resolved in *Bonito Boats*. It is undisputed that Petitioner's state law

unjust enrichment claim is based on Respondent's alleged use of ideas that are unpatented and publicly known. This Court held in *Bonito Boats* that such unpatented, publicly known ideas are freely available to the public as a matter of federal law:

> We have long held that after the expiration of a federal patent, the subject matter of the patent passes to the free use of the public as a matter of federal law. (Citations omitted.) . . .
>
> In our decisions in *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 84 S. Ct. 784, 11 L. Ed. 2d 661 (1964), and *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 84 S. Ct. 779, 11 L. Ed. 2d 669 (1964), we found that publicly known design and utilitarian ideas which were unprotected by patent occupied much the same position as the subject matter of an expired patent.

Bonito Boats, 489 U.S. at 152.

REASONS FOR DENYING THE PETITION

A. The Federal Circuit Was Correct In Construing The Claim Of The Patent-In-Suit *De Novo*

Petitioner's first argument to this Court is: "Certiorari Should Be Granted To Address The *De Novo* Scope Of Review Announced In *Cybor*." (Petition, p. 10.) Petitioner spends eight pages (10-17) on the abstract argument that the Federal Circuit's *de novo* standard of review for claim construction is improper because it allows for *de novo* review of fact questions. Yet Petitioner does not identify any

conflicting evidence resolved by the Federal Circuit in this case. Petition's sole reference to *this* case is a single paragraph:

> The disputed claim term here — "flange" — is a technical term of art, and under the Federal Circuit's own cases, technical terms must be construed through the eyes of skilled artisans. How a skilled artisan would view the meaning of the word "flange" in a particular context is a question of fact. The application of the patent claim language to the facts, as found, is ultimately a question of law; but there can be no denying that questions of fact are necessary to that ultimate inquiry. Clearly, the District Court recognized this, because it assessed the meaning of flange purely in factual terms and entered a detailed set of findings defining it. (App. 21a-41a). This is not to say that the Federal Circuit cannot review the meaning of terms *de novo* when the intrinsic record is sufficient. However, in this case, it is undisputed that reliance on extrinsic evidence is required.

(Petition, pp. 17-18.)

Petitioner's arguments are entirely conclusory. Further, it is not "undisputed that reliance on extrinsic evidence is required." Petitioner identifies no conflicting evidence, no fact resolution by the Federal Circuit — because it can't. The Federal Circuit's claim construction on the term "flange" was as follows:

> In this case, the term "flange" is not given a specific meaning in the intrinsic record. However,

> a dictionary definition is readily available: "flange, n. . . . 1. a raised or projecting edge, rib, or rim for strength, as in a T-rail; for guidance, as on a rail to keep wheels in place; for connection with some other object, as in some pipes; 2. a tool for making flanges." *Webster's New Twentieth Century Dictionary, Unabridged* 696 (2d ed. 1962). The specification and drawings of the '710 patent demonstrate that definition 1 most adequately represents what the inventor intended to claim in his invention. For example, Figures 1-3 illustrate a raised or projecting edge or rim. Further, the patent states "inboard side flange 40 may be integral with flat panel 36 and stiffened by bending it back upon itself. Inboard side flange 40 is preferably at about a 5 degree angle to the plane within which flat panel 36 lies." *See* '710 patent, col. 2, 1. 65-col. 3,1.2. Similarly, when describing an outboard flange the patent explains that the flange runs the length of the panel and is angled downward from the plane of the flat panel. *See Id.* at col. 3, ll. 8-12. There is nothing in the patent specification to indicate that the flange is coplanar with the flat panel. Accordingly, we construe the claim term "flange" to mean a raised or projecting edge.

(Petitioner's Appendix, pp. 6a-7a.)

The Federal Circuit did not even consider expert testimony, let alone resolve competing expert testimony or address credibility issues.[1]

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1. The only fact question suggested by this Court in its *Markman* decision was the resolution of competing expert testimony, and this (Cont'd)

In short, the Federal Circuit did not resolve competing factual evidence to interpret the claims in *this* case. *De novo* review is entirely proper on the facts of this case, regardless of Petitioner's view of *Cybor*. Petitioner is seeking an advisory opinion regarding *Cybor*, and that is improper. *See Lambrix v. Singletary*, 520 U.S. 518, 522-23 (1997). The petition should be denied.

B. The Federal Circuit Was Correct In Ordering JMOL Of Non-Infringement

Petitioner also seeks an advisory opinion on its second issue. Petitioner again argues in the abstract that the Federal Circuit should not order JMOL of non-infringement when it changes the claim construction on appeal, because a plaintiff may present different evidence on remand. (Petition,

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(Cont'd)

Court stated it was "doubtful that trial courts will run into many cases like that":

> It is, of course, true that credibility judgments have to be made about the experts who testify in patent cases, and in theory there could be a case in which a simple credibility judgment would suffice to choose between experts whose testimony was equally consistent with a patent's internal logic. But our own experience with document construction leaves us doubtful that trial courts will run into many cases like that. In the main, we expect, any credibility determinations will be subsumed within the necessarily sophisticated analysis of the whole document, required by the standard construction rule that a term can be defined only in a way that comports with the instrument as a whole.

Markman v. Westview Instruments, Inc., 517 U.S. 370, 389 (1996).

pp. 18-19.) But the Petitioner does not identify any different evidence that it would submit in this case. Again, Petitioner's arguments are conclusory and abstract:

> . . . assuming *arguendo* that the Federal Circuit properly construes a claim in a manner different than the District Court, the case should be remanded. On remand, the District Court may decide the case on summary judgment if the evidence is insufficient or there is no genuine dispute. However, it is a denial of litigants' right to a jury trial and Due Process for the Federal Circuit to assume that the evidence presented would not have differed in light of the newly construed claims. Therefore, the Federal Circuit can not rely on the settled record for the purposes of a judgment as a matter of law.

(Petition, p. 18.)

Petitioner does not identify any new evidence because it cannot. The accused device is very simple, and its nature is undisputed — it is a flat rectangular piece of plastic used as a fender liner. The patent claim requires a flange, and the Federal Circuit held that a "flange" is "a raised or projecting edge." There is no evidence, and Petitioner cannot offer any evidence, that a flat rectangular piece of plastic has "a raised or projecting edge." Therefore, Petitioner cannot prove infringement on remand.

Again, Petitioner's attempt to seek an advisory opinion is improper. *Lambrix*, 520 U.S. at 522-23. The Petition should be denied.

C. The Federal Circuit Was Correct In Holding The Petitioner's State Law Unjust Enrichment Claim Is Preempted By Federal Law, Because The State Law Claim Is Based On Unpatented Ideas That The Petitioner Publicly Disclosed

As a supplement to its patent infringement claim, Petitioner also asserted a catch-all, state law unjust enrichment claim in the trial court. Petitioner alleged that Respondent used unidentified, unpatented "ideas" in Respondent's accused fender liner. It is undisputed, however, that the "ideas" on which Petitioner's unjust enrichment claim was based were publicly disclosed by Petitioner. In *Bonito Boats*, this Court addressed at length, and rejected, the state law relief Petitioner seeks. This Court first discussed prior cases holding that unpatented, publicly known ideas are free for all to use:

> We have long held that after the expiration of a federal patent, the subject matter of the patent passes to the free use of the public as a matter of federal law. *See Coats v. Merrick Thread Co.*, 149 U.S. 562, 572, 13 S. Ct. 966, 969, 37 L. Ed. 847 (1893) ("[P]laintiffs' right to the use of the embossed periphery expired with their patent, and the public had the same right to make use of it as if it had never been patented"); *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 59 S. Ct. 109, 83 L. Ed. 73 (1938); *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169, 16 S. Ct. 1002, 41 L. Ed. 118 (1896). . . .
>
> In our decisions in *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 84 S. Ct. 784, 11 L. Ed. 2d

> 661 (1964), and *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 84 S. Ct. 779, 11 L. Ed. 2d 669 (1964), we found that publicly known design and utilitarian ideas which were unprotected by patent occupied much the same position as the subject matter of an expired patent.

Bonito Boats, 489 U.S. at 152.

This Court then explained how federal patent policy preempts any state law from protecting such unpatented, public ideas:

> At the heart of *Sears* and *Compco* is the conclusion that the efficient operation of the federal patent system depends upon substantially free trade in publicly known, unpatented design and utilitarian conceptions. . . .
>
> * * *
>
> A state law that substantially interferes with the enjoyment of an unpatented utilitarian or design conception which has been freely disclosed by its author to the public at large impermissibly contravenes the ultimate goal of public disclosure and use which is the centerpiece of federal patent policy.

Id. at 156-57.

Finally, this Court explained that parties such as Respondent have a federal right to copy and use such unpatented, public ideas:

> Where an item in general circulation is unprotected by patent, "[r]eproduction of a functional attribute is legitimate competitive activity." *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 863, 102 S. Ct. 2182, 2193, 72 L. Ed. 2d 606 (1982) (WHITE, J., concurring in result). *See also Bailey v. Logan Square Typographers, Inc.*, 441 F.2d 47, 51 (CA7 1971) (Stevens, J.) ("[T]hat which is published may be freely copied as a matter of federal right").
>
> . . . For almost 100 years it has been well established that in the case of an expired patent, the federal patent laws do create a federal right to "copy and to use." *Sears* and *Compco* extended that rule to potentially patentable ideas which are fully exposed to the public.

Id. at 164-65.

Against this background, the Federal Circuit correctly held that Petitioner could not maintain a state law unjust enrichment claim in this case:

> Because there is no genuine issue of material fact that Waner's fender liner was introduced to and available to the public, we affirm the district court's grant of partial summary judgment on Waner's unjust enrichment claim in favor of Ford.

(Petitioner's Appendix, p. 12a.)

CONCLUSION

The Petitioner seeks two advisory opinions, and relief that this Court has already rejected. The petition should be denied.

Respectfully submitted,

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